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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,918	08/13/2001	John Paulson	PAULJO-4	8046

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[REDACTED] EXAMINER

MITCHELL, KATHERINE W

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3677

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/928,918	PAULSON, JOHN
	Examiner Katherine Mitchell	Art Unit 3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 June 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) 9-15 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 9-15 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 9-15 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 9-15 are to a retaining wall system including stacked blocks, geosynthetic material, and a resilient pad. The originally filed claims were to a pad capable of being disposed between blocks and transferring a load, but which could be used for other purposes including a gasket or membrane between any two hard surfaces. The claims did not positively require both a pad and a geosynthetic soil reinforcing material, and did not require a plurality of stacked blocks.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Forsberg US Patent 4914876.

Re claim 1: Forsberg teaches a pad (353) comprising resilient material capable of being disposed between block layers in a wall, capable of transferring tensile load from a geosynthetic soil reinforcing material to the wall block face in col 8 lines 42-61 and Figs. 27 and 28.

Re claims 4 and 6-7: Forsberg teaches a pad (353) comprising resilient material with a thickness sufficient to substantially fill voids and uneven surfaces between adjacent horizontal surfaces of retaining blocks in Fig. 27, especially considering that no specifics on voids and uneven surfaces is provided.

Note that col 8 lines 42-61 teach that the pad 353 further anchors the wall and helps maintain the block positioning. Flexible sheets between blocks inherently reduce cracking due to the thickness and compressibility of the sheet.

Re claim 5: Forsberg teaches a polymeric geomembrane pad {flat sheet of flexible and high strength polymer plastic} in col 8 lines 42-61 and Figs. 27 and 28.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forsberg US Patent 4914878 in view of Blanc US Patent 2687034. Forsberg, as discussed above, teaches a resilient pad between horizontal layers of blocks. However, Forsberg

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does not specify that the pad should be shaped to approximately match the horizontal surface of the blocks. Blanc teaches a resilient pad between horizontal layers of blocks shaped to approximately match the horizontal surface of the blocks. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Forsberg to include a resilient pad shaped to approximately match the horizontal surface of the blocks as taught by Blanc in order to ensure that the contact surfaces are covered without wasting material, if the pad is needed to serve as a gasket.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forsberg US Patent 4914878 in view of Brown et al. US Patent 3813838. Forsberg, as discussed above, teaches a resilient pad between horizontal layers of blocks. However, Forsberg does not specify that the pad should be shaped to approximately match the horizontal surface of the blocks. Brown et al. teaches a resilient pad between horizontal layers of blocks shaped to approximately match the horizontal surface of the blocks. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Forsberg to include a resilient pad shaped to approximately match the horizontal surface of the blocks as taught by Brown et al. in order to ensure that the contact surfaces are covered without wasting material, if the pad is needed to serve as a gasket.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forsberg US Patent 4914878 in view of Firnkas US Patent 3691708. Forsberg, as discussed above, teaches a resilient pad between horizontal layers of blocks. However, Forsberg

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does not teach specific materials. Firnkas teaches a resilient gasket, for use between blocks, of vinyl chloride polymers and copolymers or materials with similar properties of flexibility, durability, resilience, and toughness in col 4 lines 3-16. Therefore, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have selected polyvinyl chloride for the resilient material of the pad as taught by Firnkas, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forsberg US Patent 4914878 in view of Amata US Patent 5045377. Forsberg, as discussed above, teaches a resilient pad between horizontal layers of blocks. However, Forsberg does not teach specific materials. Amata teaches a resilient geogrid, for use in soil retention and reinforcement systems, which can be made of PVC or punched nonwovens in col 2 lines 39-60. Therefore, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have selected polyvinyl chloride or needlepunched geotextiles for the resilient material of the pad as taught by Amata, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

#### ***Response to Arguments***

9. Applicant's arguments filed 6-19-2003 have been fully considered but they are not persuasive.

10. In response to applicant's argument that the Forsberg reference fails to show certain features of applicant's invention {the pad of the claimed invention has certain properties as listed in Tables 1-11}, it is noted that the features upon which applicant relies (i.e., pullout force requirements, enhanced at the edge) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner notes that Forsberg col 8 lines 42-61 teach that the pad in combination with pins serves to further anchor the blocks and interconnect the blocks, thus it is inherently capable of transferring tensile load from a geosynthetic material to a block face.

11. In response to applicant's argument that the Blanc and Brown references are not used in a retaining wall, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is **capable** of performing the intended use, then it meets the claim. Further, examiner notes that foundation walls, which are retaining walls, are commonly made of hollow cinder blocks, and cinder blocks are frequently used as retaining walls in gardens. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

12. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, The Amata and Firnkas references were used only to teach that specific materials were known, at the time the invention was made, as resilient materials' components due to their strength, stability, and durability. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine Mitchell whose telephone number is 703-305-6713. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4180.

kwm  
August 1, 2003

*jjswann*

J. J. SWANN  
SUPERVISORY PATENT EXAMINER  
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